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REMARKS

The Examiner is thanked for the careful review of the application as set forth in the outstanding office action. Reconsideration of the application is respectfully requested.

Allowable Subject Matter

Claims 1-21, 24, 29-30, 32 and 34-36 have been allowed.

Claims Rejections - 35 USC 103(a)

Claims 22-28, 31 and 33 have been rejected as being unpatentable over Hayward et al. ("Hayward"). The rejection is respectfully traversed on the grounds that a prima facie case of obviousness has not been established, and the applied reference does not teach or suggest the claimed subject matter. It is noted that Claim 24 is apparently erroneously included within the group of claims 22-28, as it is indicated as allowed in the office action. Applicants will treat Claim 24 as allowed.

Claim 22 is drawn to a method, in a printing system having consumable print media and a cartridge with consumable marking agent, comprising:
detecting when a trigger event occurs within the cartridge; and
placing an order for additional print media when the trigger event is detected.

The Examiner alleges that Hayward describes this method as follows:
printing system (column 9: lines 33-42 and Figure 8) having a consumable print media (column 9, line 42, paper) and a cartridge with consumable marking agent (column 9, lines 41-41, toner, and toner cartridge);
detecting when a trigger event occurs within the cartridge (column 8: lines 26-31);

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and placing an order for additional print media when the trigger event is detected (Column 9: lines 21-26, electronic order is automatically initiated for a replacement consumable component).

Applicants respectfully disagree with the Examiner's recitation of the teachings of Hayward. Hayward does not teach, for example, that an order for additional print media is placed when a trigger event occurs within the cartridge. Instead, Hayward teaches that the marking apparatus or remote device may interrogate the consumable component 11 for information, and then process and communicate such information to another remote device or server. Hayward states that the information may be communicated electronically to a remote device 50 regarding the condition of the consumable component 11 and automatically initiate an electronic order for a replacement of the consumable component 11. See, Hayward, 9:12-42. Thus, the rejection does not meet the claim limitations.

Hayward teaches that the condition of the consumable component 11 causes an order for replacement of the consumable component. Hayward does not teach or suggest that a trigger event occurring within a cartridge with consumable marking agent causes the placement of an order for additional print media. At most, Hayward suggests that a threshold condition in the toner cartridge would trigger a replacement order for a toner cartridge.

At paragraph 4, pages 8-9 of the office action, the Examiner addressed one of applicants' arguments. The office action states "Examiner maintains that Hayward does teach ordering for additional print media when a trigger occurs within the cartridge (e.g. col. 8, lines 26-31 and col. 9, lines 21-26, clearly describes how an event triggering the consumption of ink is detected and an order is placed to order print media, as the paper tray is near empty)." Applicants respectfully disagree with this recitation of alleged teachings of Hayward, and request reconsideration of this position.

The particular passages of Hayward cited by the Examiner at paragraph 4 of the office action are quoted below:

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Col. 8, lines 26-31:

The condition may be used to indicate when a consumable has been exhausted (e.g. paper tray empty) or a consumable has reach [sic] a predetermined threshold (e.g. magenta ink level low). Preferably, the condition indicates when the consumable has reached a threshold in time to reorder before the consumable is completely exhausted.

Col. 9, lines 21-26:

A modem 34, Internet connection 36, or server 40 may be used to electronically communicate the information from the marking apparatus to the remote output device 50 regarding the condition of the consumable component 11 and automatically initiate an electronic order for a replacement of the consumable component 11.

Applicants respectfully submit that these passages of Hayward teach that a condition of a consumable component indicates when an order should be placed for that consumable component, i.e. when the paper tray is nearly empty, initiate an order for paper, or when the magenta ink is low, initiate an order of magenta ink. These passage do not teach or suggest placing an order for additional print media when a trigger event is detected in the cartridge containing a consumable marking agent.

Because Hayward does not support the Examiner's interpretation, a prima facie case of obviousness of Claim 22 has not been established, and the rejection should be withdrawn. The claims depending from Claim 22 further distinguish from Hayward. The rejection of these claims should also be withdrawn.

Similar considerations apply to Claim 31, which is drawn to a printer comprising:

- a cartridge containing a consumable marking agent;
- a detector to sense a level of marking agent within the cartridge;
- a supply of consumable print media; and

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a controller configured to place an order for additional print media when the detector senses a low level of marking agent.

For reasons discussed above, Hayward does not teach or suggest a controller as recited in Claim 31, and a prima facie case of obviousness has not been established.

Claim 33 is drawn to a computer coupled to a print device, the print device comprising a supply of consumable print media, a consumable marking agent, and a detector to sense a level of the marking agent, the computer comprising:

a printer controller configured to place an order for additional print media when the detector senses a low level of marking agent.

For reasons discussed above, Hayward does not teach or suggest a printer controller configured in the manner recited in Claim 33. A prima facie case of obviousness has not been established. The rejection should be withdrawn.

Claim 27 stands rejected as being unpatentable over Hayward in view of Kurz et al. ("Kurz"). This ground of rejection is respectfully traversed on the grounds that a prima facie case of obviousness has not been established. Claim 27 depends from Claim 22 and so the discussion of Claim 22 also applies to Claim 27.

The Examiner alleges that it would have been obvious to one skilled in the art to have used the manual order notice as taught by Kurz in the system and method taught by Hayward because the Kurz teachings provide the ability for a user to contact the vendor via phone (column 5, lines 26-34, warning includes vendor phone number). Applicants respectfully disagree with this line of reasoning, on the grounds there is no motivation to combine the references in the manner suggested by the Examiner. Moreover, modifying Hayward in the manner suggested by the Examiner would result in a system which is unsuitable for the intended purpose of Hayward.

The Examiner has acknowledged that Hayward does not teach "a cartridge comprising memory storing a vendor telephone number, and wherein the placing an order further comprises: retrieving the vendor telephone number from the

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memory; contacting the vendor by way of the telephone number; and providing an order to the vendor." The Examiner recites various alleged teachings of Kurz, and then states, without setting a rational for a motivation to combine, that as a result it would be obvious to modify Hayward with alleged features of Kurz to arrive at the invention of Claim 27.

Applicants respectfully submit that this line of reasoning does not establish prima facie the obviousness of applicants' invention. Particularly, there is no teaching, suggestion or motivation to combine the references.

As the Federal Circuit has recognized, most if not all inventions are combinations and mostly of old elements, and so an examiner can often find each element of a claimed invention in the prior art. Of course, if identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would issue. Rejecting patents solely by finding corollaries of the claimed elements in the prior art would permit an examiner to use the claimed invention as a blueprint for piecing together elements in the prior to defeat patentability. To prevent the use of hindsight based on the invention to defeat patentability, the examiner is required to show a motivation to combine the references used to create the case of obviousness. Thus, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. In re Rouffet, 47 USPQ 2d 1453, 1458 (Fed. Cir. 1998).

Here, the Examiner has failed to present any reasons for modifying Hayward with teachings from Kurz. The rejection is the product of prohibited hindsight reconstruction, and should be withdrawn.

A further reason for withdrawing the rejection of Claim 27 is that the proposed modification renders Hayward unsatisfactory for its intended purpose. Hayward's intended purpose is to automatically send an offer to purchase a replacement part upon identification of a threshold condition, see, e.g., Abstract. See also 1:48-50 ("the present invention relates to a system for automatically ordering consumable supplies for a marking apparatus."). To modify Hayward to

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use a manual order notice as taught by Kurz would render Hayward unsuitable for its intended purpose of automatically ordering supplies. As noted at MPEP 2143.01, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification, citing In re Gordon, 221 USPQ 1125 (Fed.Cir. 1984).

Withdrawal of the rejection of Claim 27 is respectfully requested.

Conclusion:

The outstanding rejections have been addressed, and the application is in condition for allowance. Such favorable reconsideration is solicited.

Respectfully submitted,



Larry K. Roberts
Registration No. 28,464

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Law Offices of Larry K. Roberts, Inc.
P.O. Box 8569
Newport Beach, CA 92658-8569
Telephone (949) 640-6200
Facsimile (949) 640-1206

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DIRECTOR OFFICE
TECHNOLOGY CENTER 26110